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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,080	01/22/2001	Madeleine M. Joullic	9596-303U1 (M2163)	5576

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ONE COMMERCE SQUARE
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PHILADELPHIA, PA 19103-7013

EXAMINER

MOHAMED, ABDEL A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/767,080	JOULLIE ET AL.	
	Examiner	Art Unit	
	Abdel A. Mohamed	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

For Restriction Purposes only

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, 19-21 and 27-38 drawn to a composition comprising a tamandarin analog having the structure recited in claim 1 in which the molecule is not tamandarin A, a support having a tamandarin analog and a pharmaceutical formulation thereof, classified in classes 530 and 514, subclasses 317 and 10, respectively.
 - II. Claims 14, 22 and 39, drawn to a method of inhibiting protein synthesis in a cell by administering the composition of claims 1, 19 and 27, respectively resulting in inhibition of growth and proliferation (claims 15-16, 23-24 and 40-41) wherein it is (a) tumorigenesis inhibition (claims 17, 25 and 42) or apoptosis enhancement (claims 18, 26 and 43), classified in class 514, subclasses 10 and 11.
 - III. Claims 44-55, drawn to a method of making a tamandarin or a didemnin analog by incorporating deoxo-proline residue (claims 44-49) or dehydro-proline residue (claims 50-55) in place of a proline residue of the analog, classified in class 530, subclass 402.

2. The inventions are distinct, each from the other because:
3. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the method of making deoxy-proline or dehydro-proline containing tamandarin analog by incorporating or coupling or conjugating reactants; can be made of an alternative method of using other reactants such as methyl-leucine or methyl-alanine reactants.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the searches for individual subject groups are not coextensive, restriction for examination purposes as indicated is proper.
5. If Applicant elects Group I (a composition comprising a tamandarin analog having the structures of independent claims 1 or 19 or 27), Applicant has to define each R recited in independent claims 1 or 19 or 27. Claims 1 or 19 or 27 are generic to a plurality of disclosed patentably distinct species comprising of a family of oligopeptide which encompass a various modifications of poly amino side chains, etc., substituent of different compound species and derivatives that require different classification, and as such, different bibliographic and/or literature, manual and computer search (i.e.,

burdensome search necessary). Therefore, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species along elected method groups (i.e., a single compound with a single method claim of Group II using the single compound), and to list all claims readable thereon including those subsequently added, even though this requirement is traversed. Further, Applicant should include a chemical structure of the elected species/compound if it is not disclosed in the specification.

Should Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the species/inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was made to Gary D. Colby on 8/21/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

CONCLUSION AND FUTURE CORRESPONDENCE

9. Claims 1-55 is subject to restriction or election requirement including species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (703) 308-3966. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 5:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Mohamed/AAM

August 21, 2003


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800